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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,028	01/08/2001	Arnold L. Levine	03848.00061	4950

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EXAMINER

SISSON, BRADLEY L

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 06/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

09/755,028

Applicant(s)

LEVINE ET AL.

Examiner

Bradley L. Sisson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Oath/Declaration

1. The following is a quotation of the appropriate paragraph of 37 CFR 1.67(b) that form the basis for the objection under this section made in this Office action:

A supplemental oath or declaration meeting the requirements of § 1.63 must be filed when a claim is presented for matter originally shown or described but not substantially embraced in the statement of invention or claims originally presented or when an oath or declaration submitted in accordance with § 1.53(f) after the filing of the specification and any required drawings specifically and improperly refers to an amendment which includes new matter. No new matter may be introduced into a nonprovisional application after its filing date even if a supplemental oath or declaration is filed. In proper situations, the oath or declaration here required may be made on information and belief by an applicant other than the inventor.

As a result of amendment(s) to the claim(s), the pending claims no longer substantially embrace the invention as set forth in the statement of the invention and/or in the original claims.

Accordingly, applicant is required to file a supplemental oath or declaration in response to this Office action.

Specification

2. The specification is objected to as documents have been improperly incorporated by reference. As set forth in *Advanced Display Systems Inc. v. Kent State University* (Fed. Cir. 2000) 54 USPQ2d at 1679:

Incorporation by reference provides a method for integrating material from various documents into a host document--a patent or printed publication in an anticipation determination--by citing such material in a manner that makes it clear that the material is effectively part of the host document as if it were explicitly contained therein. *See General Elec. Co. v. Brenner*, 407 F.2d 1258, 1261-62, 159 USQP 335, 337 (D.C. Cir. 1968); *In re Lund*, 376 F.2d 982, 989, 153 USPQ 625, 631 (CCPA 1967). **To incorporate material by reference, the host document must identify with detailed particularity what specific material it incorporates and clearly indicate where that**

material is found in the various documents. See *In re Seversky*, 474 F.2d 671, 674, 177 USPQ 144, 146 (CCPA 1973) (providing that incorporation by reference requires a statement “clearly identifying the subject matter which is incorporated and where it is to be found”); *In re Saunders*, 444 F.2d 599, 602-02, 170 USPQ 213, 216-17 (CPA 1971) (reasoning that a rejection or anticipation is appropriate only if one reference “expressly incorporates a particular part” of another reference); *National Latex Prods. Co. v. Sun Rubber Co.*, 274 F.2d 224, 230, 123 USPQ 279, 283 (6th Cir. 1959) (requiring a specific reference to material in an earlier application in order to have that material considered a part of a later application); cf. *Lund*, 376 F.2d at 989, 13 USPQ at 631 (holding that **a one sentence reference to an abandoned application is not sufficient to incorporate from the abandoned application into a new application**). (Emphasis added.)

3. The disclosure is objected to because of the following informalities: The specification makes reference to several US Patent Applications yet the current status of same is not provided.

Appropriate correction is required.

4. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code; see, for example, page 5 of the disclosure. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 31-41 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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7. For purposes of examination, claim 31, the only independent claim, has been been interpreted as encompassing the evaluation of any agent for carcinogenicity, where said agent is any compound or composition, when testing is performed using any cell from any human.

As set forth in *Enzo Biochem Inc., v. Calgene, Inc.* (CAFC, 1999) 52 USPQ2d at 1135, bridging to 1136:

To be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation.' " *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365, 42 USPQ2d 1001, 1004 (Fed. Cir. 1997) (quoting *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)). Whether claims are sufficiently enabled by a disclosure in a specification is determined as of the date that the patent application was first filed, see *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986).... We have held that a patent specification complies with the statute even if a "reasonable" amount of routine experimentation is required in order to practice a claimed invention, but that such experimentation must not be "undue." See, e.g., *Wands*, 858 F.2d at 736-37, 8 USPQ2d at 1404 ("Enablement is not precluded by the necessity for some experimentation . . . However, experimentation needed to practice the invention must not be undue experimentation. The key word is 'undue,' not 'experimentation.' ") (footnotes, citations, and internal quotation marks omitted). In *In re Wands*, we set forth a number of factors which a court may consider in determining whether a disclosure would require undue experimentation. These factors were set forth as follows: (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. *Id.* at 737, 8 USPQ2d at 1404. We have also noted that all of the factors need not be reviewed when determining whether a disclosure is enabling. See *Amgen, Inc. v. Chugai Pharm. Co., Ltd.*, 927 F.2d 1200, 1213, 18 USPQ2d 1016, 1027 (Fed. Cir. 1991) (noting that the *Wands* factors "are illustrative, not mandatory. What is relevant depends on the facts.").

8. In accordance with amended claim 31, an agent is to be considered a carcinogen if the level of transcription or translation of any gene selected from the "first group" increases or if the level of transcription or translation of any gene selected from the second group decreases wherein the measurement is to be based on a human cell that has been brought into contact with

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said agent. Review of the genes identified in said first group are “142450 VASCULAR ENDOTHELIAL GROWTH FACTOR PRECURSOR (*Rattus norvegicus*),” “39052 POTASSIUM CHANNEL PROTEIN EAG (*Drosophila melanogaster*), and 124416 SERINE THREONINE-PROTEIN KINASE COT-1 (*Neurospora crassa*)” (emphasis in the original). As so indicated in the claim, these genes are not from a human but are from other life forms, *i.e.*, *Rattus norvegicus*, *Drosophila melanogaster*, and *Neurospora crassa*. With these genes not being in human cells, there can be no expression or translation of same in said human cell. Consequently, one would not be able to detect any decrease or increase of expression or translation of same, much less make a determination of carcinogenicity.

9. In claim 31, “first group,” it is noted that one of the “genes” to be monitored is not a gene, but rather, is a human (*Homo sapiens*): “*Homo sapiens* of cardiac alpha-myosin heavy chain gene.” The disclosure is silent as to how one is to be monitoring expression of humans from a given gene when the *Homo sapiens* are to be a gene within the human cell.

10. Aside from claim 31 requiring the monitoring the level of transcription or translation of genes not in humans, or the expression of humans, other identified “genes” are not genes. For purposes of examination the term “gene” has been interpreted as encompassing not only the actual coding sequence but regulatory sequences and introns sequences as well. Upon review of the groupings it is evident that the complete gene sequence for these “genes” is not provided, *i.e.*, “Human mRNA (KIAA0098) for ORF (human counterpart of mouse chaperonin containing TCP-1 gene), partial cds.” Clearly, if the sequence is that of mRNA, the promoter region and introns are not present. Furthermore, the fact that it is not a complete sequence, as is evidenced by the phrase “partial cds.,” effectively prohibits translation.

11. While the specification need not teach each and every possible embodiment so to satisfy the enablement requirement set forth under 35 USC 112, first paragraph, the amount of experimentation that the public must be forced to practice cannot be undue. As shown above, the method is to be practiced where gene transcription and translation is to be monitored and evaluated. The specification has not set forth a reproducible method whereby the identified foreign genes are expressed in a human cell, much less make an assessment of carcinogenicity of an agent.

12. The claimed method fairly encompasses the assessment of carcinogenicity of an agent, e.g., culture media such as RPMI-1640 where one cell sample is given media and is allowed to grow and compare their level of expression to a second cell sample that is not given fresh media and is quiescent. In such a situation conditions that would encourage normal physiology would result in virtually every agent as being identified as a carcinogen.

13. For reasons made of record above, the specification does not set forth a reproducible method whereby any and all genes listed in claim 31 can be evaluated in human cells and an accurate determination of carcinogenicity of an agent be pronounced. Many of the issues confronting the skilled artisan are not resolvable and as such the amount of experimentation required is considered to be undue. Accordingly, and in the absence of convincing evidence to the contrary, claim 31, and claims 32-41 that depend therefrom, are rejected under 35 USC 112, first paragraph, as not being enabled by the originally-filed disclosure.

Double Patenting

14. The rejection of claims 31-41 under the judicially created doctrine of obviousness-type double patenting has been withdrawn.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

16. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley L. Sisson whose telephone number is (703) 308-3978. The examiner can normally be reached on 6:30 a.m. to 5 p.m., Monday through Thursday.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (703) 308-1119. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

19. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Bradley L. Sisson
Primary Examiner
Art Unit 1634

BLS
June 25, 2003